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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09:763,678	06/04/2001	Henry Guy Stevens		9281

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09/30/2002

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,678

Applicant(s)

STEVENSON, HENRY GUY

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/04/01 & 09/03/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-39, 50-52, 54, 57, 58 and 61-64 is/are rejected.
- 7) ☒ Claim(s) 40-49, 53, 55, 56, 59 and 60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. ***Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.***

Information Disclosure Statement

2. ***The information disclosure statement filed 06/04/01 has been considered and placed in the application file.***

Specification

3. ***This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.***

Claim Objections

4. ***Claims 40-49, 53, 55, 56, 59 and 60 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.***

Claim Rejections - 35 USC § 101

5. ***35 U.S.C. 101 reads as follows:***

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 64 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. "Use of" is not a statutory category of inventions, only processes with steps are patentable. Claim 64 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process,

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results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example Ex parte Dunki, 153 USPQ 678 (Bd.App. 1967) and Clinical Products, Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Any further action on this claim is herein being held in abeyance pending clarification of this matter.

Claim Rejections - 35 USC § 112

6. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. *Claims 35-39, 50-52, 54, 58, 63 and 64 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "up to 5% lubricant by weight" per claim 35 constitutes indefinite subject matter as per a) said phrase engenders awkwardly expressed claim language and b) it is not readily ascertainable as to the exact entity that said contents are being based on, i.e., PVA + lubricant or else. See, also claim 58 relative to item b).*

B) *The recited "selected from" per claim 39 engenders the use of improper Markush terminology, use of "selected from the group consisting of" is proper and is suggested.*

C) *The recited "glycerine" and "glycerol" per claim 39 constitutes indefinite subject matter as per it is not readily ascertainable as to how the recited compounds differentiate over one another.*

D) The recited "low molecular weight" per claim 39 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope, "low" being relative and not absolute..

E) The recited "substantially without melting" per claims 63 and 64 constitute indefinite subject matter as per the metes and bounds of "substantially" engendering an indeterminacy in scope. It is not readily ascertainable as to how much "melting" is permitted.

F) Claim 64 provides for the use of a fatty acid amide as an internal lubricant, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based

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on the filing of an international application filed under the treaty defined in section 351(a).

9. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. *Claims 35-39, 50-52, 54, 57, 58 and 62-63 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over IE 970,280, Gerontopoulos et al(U.S. 4,571,315), Weyand(4,724,121), Redd et al(U.S. 5,552,461), Loomis et al(U.S. 5,852,114) or Giltsoff(U.S. 5,948,848).*

Each of patentees disclose a polymer feedstock, in the form of a cold-pressed tablet or pellet, defined basically as containing an extrudable blend of polyvinyl alcohol, a lubricant and other conventional adjuvants which include fillers, pigments, etc. See, e.g., the Abstract of IE'280, the Abstract, cols. 2-3 and the Runs of Gerontopoulos et al, the Abstract, cols. 2-6(examples inclusive) of Weyand, the Abstract and cols. 2-7(examples inclusive) of Redd et al, the Abstract, cols. 3-14 and the Runs of Loomis et al and the Abstract, cols. 2-4 and the Runs of Giltsoff. Each of patentees therefore anticipate the instantly claimed invention with the understanding that the extrudable blend of patentees overlap in scope with the claimed extrudable blend, in both content and character.

As to the dependent claims, the limitations are either disclosed in each of patentees, suggested in each of patentees or would have been obvious to the skilled artisan and with a reasonable expectation of success.

Conclusion

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11. *The prior art made of record and not relied upon is cited as of interest in teaching polymer compositions defined basically as containing PVA, lubricant, plasticizers and other conventional adjutants and considered merely cumulative to the prior art supra.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
September 25, 2002